

REMARKS

The specification and drawings have been amended. Claims 1, 3 - 5, 7 - 9, 14, 18 - 19, 24, and 27 - 29 have been amended. Claims 2, 15, 25, and 30 have been cancelled from the application without prejudice. No new matter has been introduced with these amendments, which are supported in the specification as originally filed. Claims 1, 3 - 14, 16 - 24, 26 - 29, and 31 - 33 remain in the application.

I. Objections to the Drawings

Paragraphs 2 - 6 of the Office Action dated June 16, 2004 (hereinafter, "the Office Action") state that the Drawings are objected to for various reasons. Appropriate corrections have been made with the amendments herein, as will now be discussed.

Paragraph 2a states that each figure is not listed separately, and paragraph 2b states that reference number 1065 is not mentioned in the description. Applicants respectfully submit that the Brief Description of the Drawings sufficiently addresses each figure, in compliance with the requirements of 37 CFR 1.84, and the objection in paragraph 2a is therefore considered moot. The specification has been amended to provide mention of reference number 1065, thus fully addressing the objection in paragraph 2b.

The objection in paragraph 3 is addressed by amendment of Fig. 7 to include a new Block 705, and renumbering of existing Blocks 705 - 740, as discussed above in "Amendments to the Drawings". No new matter is added with this amendment.

Serial No. 09/879,694

-18-

Docket RSW920000177US1

Paragraph 4a states that reference number 745 is missing from the drawings. This has been corrected by the renumbering of Fig. 7. Paragraph 4b states that reference number 1085 is missing from the drawings. This has been corrected by correction of Fig. 10B (as discussed above in "Amendments to the Drawings").

Paragraph 5 states that the reference numbers of Fig. 7 do not match the description. The renumbering of Fig. 7, as provided herein, corrects these mismatches.

Accordingly, the Examiner is respectfully requested to withdraw these objections.

II. Objection to the Specification

Paragraph 7 of the Office Action states that the specification is objected to because of a typographical error. Appropriate correction has been made with the amendments herein, and the Examiner is respectfully requested to withdraw this objection.

III. Objections to the Claims

Paragraph 8 of the Office Action states that Claim 3 is objected to because of a typographical error. Appropriate correction has been made with the amendments herein.

Paragraph 9 of the Office Action states that Claim 30 is objected to for failing to further limit the subject matter of a previous claim. Claim 30 has been cancelled from the application. Paragraph 10 of the Office Action states that Claim 27 is objected to because of a missing period at the end, and Paragraph 11 states that Claims 18 - 19 are objected to because they are system claims

Serial No. 09/879,694

-19-

Docket RSW920000177US1

referring to a previous method claim. These typographical errors have been corrected with the amendments made herein. The Examiner is therefore respectfully requested to withdraw these objections.

IV. Rejection under 35 U.S.C. §101

Paragraph 13 of the Office Action states that Claims 1 - 11 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter and are merely an "abstract idea". Applicants respectfully disagree with this assertion. Amendments have been made herein to independent Claim 1 to clarify limitations of Applicants' claimed invention, and Applicants respectfully submit that amended Claim 1 and its remaining dependent Claims 3 - 11 are clearly directed to statutory subject matter.

Paragraph 14 further states that Claim 2 is considered a non-statutory, "abstract idea", because "it leaves open the possibility installation should not be performed". The limitations of Claim 2 have been incorporated into Claim 1. Applicants respectfully submit that no requirement exists for claim language to provide an exact blueprint for use of an invention. As stated by the Federal Circuit in *Moleculon Research Corp. v. CBS, Inc.*, 229 USPQ 805, 810-11 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1030 (1987)

CBS also argues that the subject matter of the claims are not "useful" because the claims do not "teach" anyone the complicated method of solving Nichols' or Rubik's puzzle. The argument misperceives the purpose of a claim (emphasis added). The claims are directed to "a method for restoring a preselected pattern." They claim a general *approach* [emphasis original] for solving the puzzle. As the district court correctly observed, neither the claims nor the disclosure need set forth (emphasis added) a *particular* [emphasis

original] series of moves to solve the puzzle.

As shown by this holding, claim language addressing one of two possible courses of action (as in Applicants' original claim language) is permissible and is not non-statutory. However, in the interest of progressing the claims rapidly to issuance, Applicants have amended the claim language adopted from now-cancelled Claim 2 to include the phrase "and programmatically suppressing the installation otherwise", which addresses the second of two possible courses of action.

In view of the above, the Examiner is therefore respectfully requested to withdraw the rejections in Paragraphs 13 and 14.

V. Rejection under 35 U.S.C. §112, second paragraph

Paragraph 17 of the Office Action states that Claim 4 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite due to use of a trademark. Appropriate correction has been made herein, and the Examiner is respectfully requested to withdraw this rejection.

Paragraph 18 of the Office Action states that Claims 5 - 9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite due to use of the term "component", which "renders the claims indefinite". Applicants interpret this Office Action comment to mean that use of "component" in reference to the "suite-level" is confusing. Accordingly, claims referring to suite-level components have been amended to use the term "elements" instead. The Examiner is

Serial No. 09/879,694

-21-

Docket RSW920000177US1

therefore respectfully requested to withdraw this rejection.

VI. Provisional Double-Patenting Rejections

Paragraph 20 of the Office Action states that Claim 1 is provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims of commonly-assigned and co-pending application 09/930,325 (hereinafter, "the '325 application"). Paragraph 21 states that Claims 3 - 4 are provisionally rejected over Claims 2 - 3 of the '325 application in view of U. S. Patent 5,870,611 to London Shrader et al.

Applicants have submitted herewith a terminal disclaimer identifying the '325 application. The Examiner is therefore respectfully requested to withdraw the double-patenting rejection of Claims 1, 3, and 4.

Paragraph 22 of the Office Action states that "other pending applications" contain "similar claims and are not patentably distinct". Applicants respectfully request that a proper showing be made out, stating which claims of which co-pending applications are deemed to be of concern, thereby allowing Applicants to properly address such a rejection. In the absence of this showing, Applicants respectfully request that the rejection in paragraph 22 be withdrawn.

VII. Rejection under 35 U.S.C. §103(a)

Paragraph 23 of the Office Action states that Claims 1, 3, 12 - 14, 16 - 17, and 22 - 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 5,870,611 to

Serial No. 09/879,694

-22-

Docket RSW920000177US1

London Shrader et al. (hereinafter, "Shrader") in view of U. S. Patent 5,860,012 to Luu. Paragraph 34 states that Claims 2, 5 - 11, 15, 18 - 21, and 25 - 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shrader and Luu in view of U. S. Patent 6,744,450 to Zimniewicz et al. Paragraph 56 states that Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shrader and Luu in view of U. S. Patent 6,637,020 to Hammond. These rejections are respectfully traversed.

Paragraph 24 of the Office Action admits that Shrader does not teach limitations of Applicants' independent Claim 1. The Office Action then cites Luu as teaching these limitations. Claim 1 has been amended herein to incorporate limitations from now-cancelled Claim 2, and as admitted by the Office Action in paragraph 35, Luu fails to teach limitations of Claim 2. Applicants therefore respectfully submit that a combination of Shrader and Luu (if, *arguendo*, such combination could be made and one of skill in the art would be motivated to attempt it) fails to yield amended Claim 1. Paragraph 35 of the Office Action continues by stating that Zimniewicz teaches limitations from Claim 2 which are now incorporated into Claim 1. Applicants respectfully disagree, as will now be discussed.

The Office Action cites col. 8, lines 33 - 52 of Zimniewicz, and states that this text teaches allowing a user to choose not to install. Applicants have amended their independent Claims 1, 14, and 24 to specify that the installation is "programmatically" suppressed in the case where using the conditional installation information results in determining that the installation should not be performed. Programmatically suppressing the installation is patentably distinct

Serial No. 09/879,694

-23-

Docket RSW920000177US1

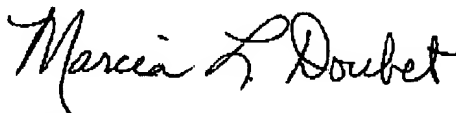
from giving a human being the option to not install.

In view of the above, Applicants respectfully submit that their independent Claims 1, 14, and 24 are patentable over a combination of Shrader, Luu, and/or Zimmiewicz. The dependent claims are therefore deemed patentable as well, and the Examiner is respectfully requested to withdraw the §103 rejection.

VIII. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding objections and rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,



Marcia L. Doubet
Attorney for Applicants
Reg. No. 40,999

Customer Number 43168
Phone: 407-343-7586
Fax: 407-343-7587

Attachments: Replacement Sheets (3)

Serial No. 09/879,694

-24-

Docket RSW920000177US1